



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/210,057	12/10/98	SHIPLEY	P 16355-11C1

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LM02/0812

EXAMINER

ELISCA, P

ART UNIT

PAPER NUMBER

2785

DATE MAILED:

08/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/210,057

Applicant(s)

Shipley, Peter M.

Examiner
Pierre Eddy Elisca

Group Art Unit
2785



☒ Responsive to communication(s) filed on Oct 7, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Examiner Pierre Eddy Elisca

United States Department of Commerce

Patent and Trademark Office

Washington, D. C. 20231

DETAILED ACTION

1. Claims 1-27 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. Claims 21-27 are rejected under 35 U.S.C. 101 for as being directed to non-statutory subject matter. Computer program products that are not claimed as embodied in computer readable media are descriptive material per se and are not statutory since they are neither physical things nor statutory processes. Moreover, claims 21-27 do not positively recite that the functions are being performed by the code housed on the medium.

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Therefore, Examiner suggests to the Applicant's representative as follow: **"A computer program product which includes codes on a computer readable medium wherein codes are being executed by a computer system, comprising"**.

Claim Rejections - 35 USC § 102 (e)

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 (e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1, 3, 5-12, and 21-27, are rejected under 35 U.S.C. 102 (e) as being anticipated by Shwed (U.S. Pat. No. 5,606,668).

As per claims 1, 8, 21, 23, 24, and 26, Shwed discloses the claimed method of a computer system connected to an external communications medium, a security device comprising :

A programmable firewall device (gateway) interposed between the computer system and the external communications medium; a controller device (packet filter module) configured within the computer system such that controller device can access all communications into and out the computer system (e.g.see., Abstract, lines 1-7, Figure 2, Elements 106, and 208, col 3, lines 31-48); a communications

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device for communicating instructions from controller device to firewall device (e.g.see., Figure 2, Element 108, col 3, lines 27-33). The step of detecting patterns operational routine wherein a pattern of activity is detected over time (see., col 6, lines 7-35).

As per claim 3, Shwed discloses the claimed method wherein the external communications medium is the Internet (e.g.see., Figure 2, col 3, lines 27-33).

As per claims 5, 6, 22, 25, and 27, Shwed discloses the claimed method wherein the controller device examines communications incoming to the computer system for code known to be associated with attempted security breaches (e.g.see., Abstract, lines 1-12, col 4, lines 27-42).

As per claims 7, 9, and 10, Shwed discloses the claimed method wherein the controller device controls the firewall to block communications between the computer system and the external communications medium when an attempted security breach is detected (e.g.see., col 5, lines 6-67, col 6, lines 1-35, col 7, lines 62-67, col 8, lines 1-19).

As per claim 11, Shwed discloses the claimed method wherein the controller is a general purpose computer programmed (e.g.see., Abstract, lines 1-9, Figure 2, Element 208, col 3, lines 27-50).

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As per claim 12, Shwed discloses the claimed method wherein the controller and the firewall are each physically distinct computerized units (e.g.see., Figure 2, Elements 106, and 208, col 3, lines 27-67).

Claim Rejections - 35 USC § 103 (a)

5. The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 4, 13-20, are rejected under 35 U.S.C. 103 (a) as being unpatentable over Shwed (U.S. Pat. No. 5,606,668) as applied to claim 1, above, and further in view of Macera et al. (U.S. Pat. No. 5,490,252).

As per claims 2, 4, 13, 15, and 16, Shwed substantially discloses the claimed method, but, he does not specifically disclose wherein the computer system is a local area network.

However, Macera discloses a broadband enterprise which is a high performance, high availability Internet working nodal processor combining, for example, native-speed local area network (LAN) interconnection, high-bandwidth wide area network (WAN) access, and non-stop networking for

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mission critical applications (e.g.see., Figure 1, col 4, lines 1-47). He also discloses a Ethernet LAN (e.g.see., Figure 1, col 4, lines 31-37).

Though it is common to one of ordinary skill in the art to know that Ethernet LAN, and WAN (Internet) can connect computers, and allow users to share files and system resources. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Shwed with a Ethernet LAN as taught by Macera et al., because such modification would provide the teachings of **Shwed** with a Internet working system for exchanging packets of information between networks.

As per claim 14, Shwed substantially discloses the claimed method wherein the wide are network is the Internet (e.g.see., Figure 2, col 3, lines 27-33).

As per claims 17, and 18, Shwed substantially discloses the claimed method wherein the classification of the attempted security breach includes a factor relating to the number of attempts made in the course of the attempted security breach (e.g.see., col 5, lines 6-67, col 6, lines 1-35, col 7, lines 62-67, col 8, lines 1-19).

As per claim 19, Shwed substantially discloses the claimed method wherein the classification of the attempted security breach is accomplished by a controller unit which is physically distinct from a firewall unit (e.g.see., Figure 2, Elements 106, and 208, col 3, lines 27-67).

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As per claim 20, Shwed substantially discloses the claimed method wherein the firewall unit is controlled through a serial data link from the controller unit (e.g.see., Figure 2, Elements 106, 208, and 210, col 3, lines 27-57).

CONCLUSION

7. The prior art made of record and relied upon is considered to applicant's disclosure.

1. Pat. No. 5,623,601 Vu

This patent teaches an apparatus and method for providing a secure firewall between a private and a public network see., Abstract.

2. Pat. No. 5,343,524 Mu et al.

This patent teaches an intelligent security device for protecting computer software from unauthorized use see., Abstract.

8. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Robert W. Beausoleil Jr. can be reached on (703) 305-9713.

Any response to this action should be mailed to :

Commissioner of Patents of Trademarks Washington, D.C. 20231

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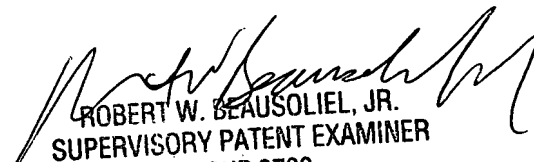
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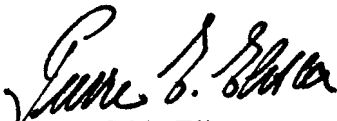
(703) 308-9051, (for formal communications intended for entry)

OR :

(703) 305-3718, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA.,
Sixth floor (receptionist).


ROBERT W. BEAUSOLIEL, JR.
SUPERVISORY PATENT EXAMINER
GROUP 2700


Pierre Eddy Elisca

Patent Examiner

August 9, 1999